



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/338,729	06/23/1999	DENNIS GROSS	10853/1	1761

26646 7590 12/31/2002

KENYON & KENYON
ONE BROADWAY
NEW YORK, NY 10004

EXAMINER

BERMAN, ALYSIA

ART UNIT PAPER NUMBER

1617

DATE MAILED: 12/31/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/338,729

Applicant(s)

GROSS, DENNIS

Examiner

Alysia Berman

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-53 is/are pending in the application.
- 4a) Of the above claim(s) 1-9,27-30,34 and 35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) is/are allowed.
- 6) ☒ Claim(s) 10,26,31-33 and 36-53 is/are rejected.
- 7) ☐ Claim(s) is/are objected to.
- 8) ☐ Claim(s) are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) .
- 4) ☐ Interview Summary (PTO-413) Paper No(s). .
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: .

Art Unit: 1617

DETAILED ACTION

Receipt is acknowledged of the amendment filed September 30, 2002. Claims 10, 16, 37, 40-41 and 44-46 have been amended. Claims 47-53 have been added. Claims 1-53 are pending.

Election/Restrictions

Claims 1-9 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention and/or species of the invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 5 and 7.

Claims 27-30, 34 and 35 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species of the invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 5.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 10-26, 31-33 and 36-53 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not appear to provide a written description of a consistency of the compositions so that the compositions are not rinsed off of the skin.

Claims 10-26, 31-33 and 36-53 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not provide a written description that the compositions are not removed from the skin.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter that the applicant regards as his invention.

Claims 10-26, 31-33 and 36-53 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are vague and indefinite because it is unclear what Applicant intends by a flowable liquid consistency. Neither the specification nor the claims provides any guidance or disclosure of a consistency or viscosity of the composition that is considered a flowable liquid consistency. The metes and bounds of the claims cannot be determined.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 16-21, 24-26, 31-33, 36, and 46 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5,720,949 (949).

This rejection is maintained for reasons of record in paper no. 16. US '949 discloses a cosmetic mask comprising a first composition and a second composition that are applied sequentially to the face. One of the compositions comprises an acid and the other comprises an effervescent agent (abstract). The effervescent agent is preferably sodium bicarbonate and the acid is an alpha-hydroxy acid such as lactic acid (col. 2, lines 35-38). The acid component makes up about 1-30% of the second composition (col. 3, lines 61-67). Lactic acid has an inherent molecular weight of about 90. The compositions may be applied using a spatula or any other convenient applicator (col. 2, lines 42-47).

The effervescent composition may comprise from about 1-20% of a surfactant system (col. 3, lines 31-33). Surfactants such as cetareths, ceteths, laneths, nonoxynols, octoxynols, glyceryl stearate, PEG-castor oil, poloxamers, poloxamines and steareths are disclosed at column 5, line 47 to column 6, line 35. US '949 discloses ethoxylated sorbitan esters with fatty acids or alcohols and ethoxylated esters having preferably 14-18 carbon atoms, which encompass polysorbate-20 (col. 5, line 60 to col. 6, line 4).

The pH of the effervescent composition is from above 7.5 to about 9, preferably between 7.8 and 8.3 (col. 7, lines 58-60). The pH of the acid composition is from about 3.5 to about 6 (col. 8, lines 50-64). As a further note, pH is an inherent property of an acid or alkaline agent. Therefore, the pH of a composition comprising an acid or an

Art Unit: 1617

alkaline agent is inherently either acidic or basic, respectively, unless specifically altered.

For additional suitable acids, see column 9, lines 8-13. See Example 1 at column 12 for one composition comprising 5.0 wt.% sodium bicarbonate, 1.5% glyceryl stearate, 5.0% cetyl alcohol, 1.5% PEG-100 stearate and 1.5% PEG-40 castor oil with a pH of 8.0 and another composition comprising 9.1% lactic acid with a pH of 4.9. The reference teaches at column 13, lines 7-9, that the composition bubbles because of the reaction between the effervescent agent and the acid. This is interpreted as meaning that the alkaline, effervescent agent neutralizes the acid component.

Claims 16-21, 24-26, 31-33, 36, and 46 are directed to a product. Any properties exhibited by the product are inherent. Applicant has not provided any limitations in the claims to distinguish the first and second compositions of the instant invention from the compositions of the prior art. The compositions of the prior art containing the same components as instantly claimed inherently exhibit the same properties. A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. *In re Spada*, 911 F.2d 705, 709, 15 USPQ 1655, 1658 (Fed. Cir. 1990). See MPEP §2112.01. The burden is shifted to Applicant to show that the prior art product does not inherently possess the same properties as instantly claimed product.

The limitations directed to a flowable liquid consistency and the compositions not being removed from the skin are not given weight because they are not supported by the specification.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10-22, 24-26, 31-33, 36, 37, 39, 40 and 43-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,720,949 (949).

This rejection is maintained for reasons of record in paper no. 16. US '949 discloses all of the limitations of the claims as stated in the 35 U.S.C. 102(b) rejection above. Claim 20 recites a method of applying a first and second composition to the skin sequentially wherein either of the first and second composition can be an acidic composition and the other is an alkaline composition. No criticality is seen in the particular order of application. At column 2, lines 42-47, US '949 teaches that the compositions are massaged into the skin. At column 10, lines 58-60, US '949 discloses that the cream mask composition is allowed to remain on the face for up to about 10 minutes. At column 11, line 66 to column 12, line 2, US '949 discloses that the composition is left on the skin for up to about 30 minutes after which time the composition can be scraped from the skin. Because the instant claims do not recite a specific time needed to allow for drying of the compositions, it is the Examiner's position that this is enough time to allow for drying.

It does not disclose octoxynol-9 (claim 22). US '949 discloses at column 6, line 18 that octoxynol-7, octoxynol -10 and octoxynol -14 are all suitable surfactants.

Art Unit: 1617

Octoxynol-9 is a known surfactant. It is within the skill in the art to substitute one known octoxynol surfactant for another, especially when the difference is only one or two ethoxy groups, and expect similar results.

It would have been obvious to one of ordinary skill in the art at the time of the invention to substitute octoxynol-9 for the octoxynol surfactants disclosed in US '949 with the reasonable expectation of obtaining the same emulsification effects.

Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,720,949 (949) as applied to claims 16-22, 24-26, 31-33, 36 and 46 above and further in view of US 4,797,273 (273) and Database REGISTRY on STN for polysorbate-20.

This rejection is maintained for reasons of record in paper no. 16. US '949 teaches all the limitations of the claims as stated as stated in the 35 U.S.C. rejections above. It does not disclose polysorbate-20. US '273 teaches that polysorbate-21, which is equivalent to polysorbate-20 as evidenced by the REGISTRY file printout for polysorbate-20 obtained on STN, is a known surfactant for use in skin care compositions (col. 6, lines 14-18).

It would have been obvious to one of ordinary skill in the art at the time of the invention to prepare the composition of US '949 using polysorbate-20 as taught by US '273 expecting to obtain an emulsified composition.

Claims 38, 41 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,720,949 (949) as applied to claims 16-22, 24-26, 31-33, 36 and 46 above, and further in view of US 5,242,433 (433).

Art Unit: 1617

This rejection is maintained for reasons of record in paper no. 16. US '949 discloses all of the limitations of the claims as stated as stated in the 35 U.S.C. rejections above. It does not disclose using a pad as an applicator for the compositions. US '433 discloses a packaging system of applicator pads for topical drug delivery and a method of applying two dermatological agents to the skin sequentially using the applicator pads (title and abstract).

It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the compositions of US '949 in a packaging system with a pad applicator as taught by US '433 expecting to provide a convenient means of dispensing a plurality of substances, overcome the physical and chemical incompatibilities of the substances and allow for sequential application.

US '347 discloses a multi-component kit comprising a first composition a second composition with a pH of 1.8-6, which overlaps the instantly claimed pH ranges of the acidic composition. The second composition comprises an acid such as alpha-hydroxycarboxylic acids. See claim 18. See Examples 1.1-1.5 bridging columns 11 and 12 for a composition comprising sodium hydroxide, sodium lauryl ether sulfate and ammonia and stripper gel compositions comprising ascorbic acid, *inter alia*. US '347 discloses an applicator at column 11, lines 64-65. The pH value of the first composition is preferably from 5 to 9 (col. 9, lines 7-8). This either overlaps or encompasses the instantly claimed pH ranges of the alkaline composition. US '347 discloses at column 9, lines 14-16 that buffers such as alkali carbonates can be added to the compositions. For surfactant/emulsifiers, see column 8, lines 52-57.

US '347 does not teach applicator pads. US '433 discloses a packaging system of applicator pads (title and abstract).

It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the compositions of US '347 in the packaging system of US '433 expecting to provide a convenient means of dispensing a plurality of substances, overcome the physical and chemical incompatibilities of the substances and allow for sequential application.

Response to Arguments

Applicant's arguments filed May 6, 2002 have been fully considered but they are not persuasive.

Applicant argues that the compositions of US '949 are paste compositions that do not flow appreciably. It is noted that this limitation is not given patentable weight because it is not supported by the specification and claims as originally filed. US '949 discloses at column 2, lines 30-35 that the compositions can be in the form of lotions and gels. Because the claims do not recite^p any particular viscosity that Applicant considers to be of flowable liquid consistency, any composition that has any amount of flow is encompassed by the claims. Gels and lotion, although thick, to exhibit some flow and, so, read on the instant claims.

Applicant argues that US '949 is distinguished from the instant invention because the compositions of US '949 are not massaged into the skin, are removed from the skin after application and there is no desirability or capability of applying makeup over the mask compositions of US '949. The claims rejected under 35 U.S.C. 102(b) are directed

Art Unit: 1617

to a product. Any future intended use of that product such as application to the skin where the compositions are not rinsed/removed or application of makeup after application of the compositions does not provide patentability to the claims. Terms merely setting forth an intended use for, or a property inherent in, an otherwise old composition do not differentiate the claimed composition from those of the prior art. *In re Pearson*, 181 USPQ 641. Difference in use cannot render claimed composition novel. *In re Tuominen*, 213 USPQ 89.

Applicant argues that there is no motivation in the cited prior art to arrive at the presently claimed invention. US '949 teaches all the limitations required by the instant claims as stated in the 35 U.S.C. 102(b) and 103(a) rejections above. The products of US '949 are intended for application to the skin to provide improved skin tone, texture and softness and remove dead cells. One of ordinary skill in the art would be motivated to apply the compositions of US '949 to the skin in order to provide improved skin tone, texture and softness and remove dead cells.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

Art Unit: 1617


mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

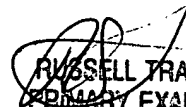
Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alysia Berman whose telephone number is 703-308-4638. The examiner can normally be reached Monday through Friday between 9:00 am and 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, can be reached on 703-305-1877. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 or 703-872-9307 for after-final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234 or 703-308-1235.


Alysia Berman
Patent Examiner
December 20, 2002


RUSSELL TRAVERS
PRIMARY EXAMINER
GROUP 1200